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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/652,147 | 08/29/2003 | Greg Hahn | 60,298-517;ST 167 | 1158 |

26096 7590 01/24/2005

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BIRMINGHAM, MI 48009

EXAMINER

RODRIGUEZ, WILLIAM H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3746

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|---|------------------------------------|--|
| Office Action Summary | Application No. 10/652,147 | Applicant(s) HAHN ET AL. | |
| | Examiner William H. Rodriguez | Art Unit 3746 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the preliminary amendment filed on 10/20/04 and originally filed on 8/29/03.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 12-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,558,126. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

With regards to claim 12 of the instant application, this claim is merely broader than claims 1 and 7 of the patent. Claim 12 of the instant application recites the following elements: *a sealed compressor shell, a compressor pump unit, an electric motor, a low voltage valve, an*

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inlet, a high voltage electric power supply, a system for converting high voltage to low voltage.

While, claims 1 and 7 of the patent recites the following elements: *a sealed compressor shell, a compressor pump unit, an electric motor, a low voltage valve, an inlet, a high voltage electric power supply, a system for converting high voltage to low voltage.* Claim 1 of the patent additionally recites a low voltage microprocessor control device. Thus, the elements recited by claim 12 of the instant application are contained within claims 1 and 7 of the patent. Therefore, claims 1 and 7 of the patent “anticipates” the broader claim 12 of the instant application.

Note: The same analysis applies to dependent claim 13-15 of the instant application. Compare claims 13-15 of the instant application with claims 2-6 of the patent.

With regards to claim 16 of the instant application, this claim is merely broader than claims 1, 6 and 7 of the patent. Claim 16 of the instant application recites the following elements: *a sealed compressor shell, a scroll compressor pump unit, an electric motor, a low voltage valve, a low voltage sensor, an inlet, a high voltage electric power supply, a system for converting high voltage to low voltage.* While, claims 1, 6 and 7 of the patent recites the following elements: *a sealed compressor shell, a compressor pump unit, an electric motor, a low voltage valve, a low voltage sensor, an inlet, a high voltage electric power supply, a system for converting high voltage to low voltage.* Claim 1 of the patent additionally recites a low voltage microprocessor control device. Thus, the elements recited by claim 16 of the instant application are contained within claims 1, 6 and 7 of the patent. Therefore, claims 1, 6 and 7 of the patent “anticipates” the broader claim 16 of the instant application.

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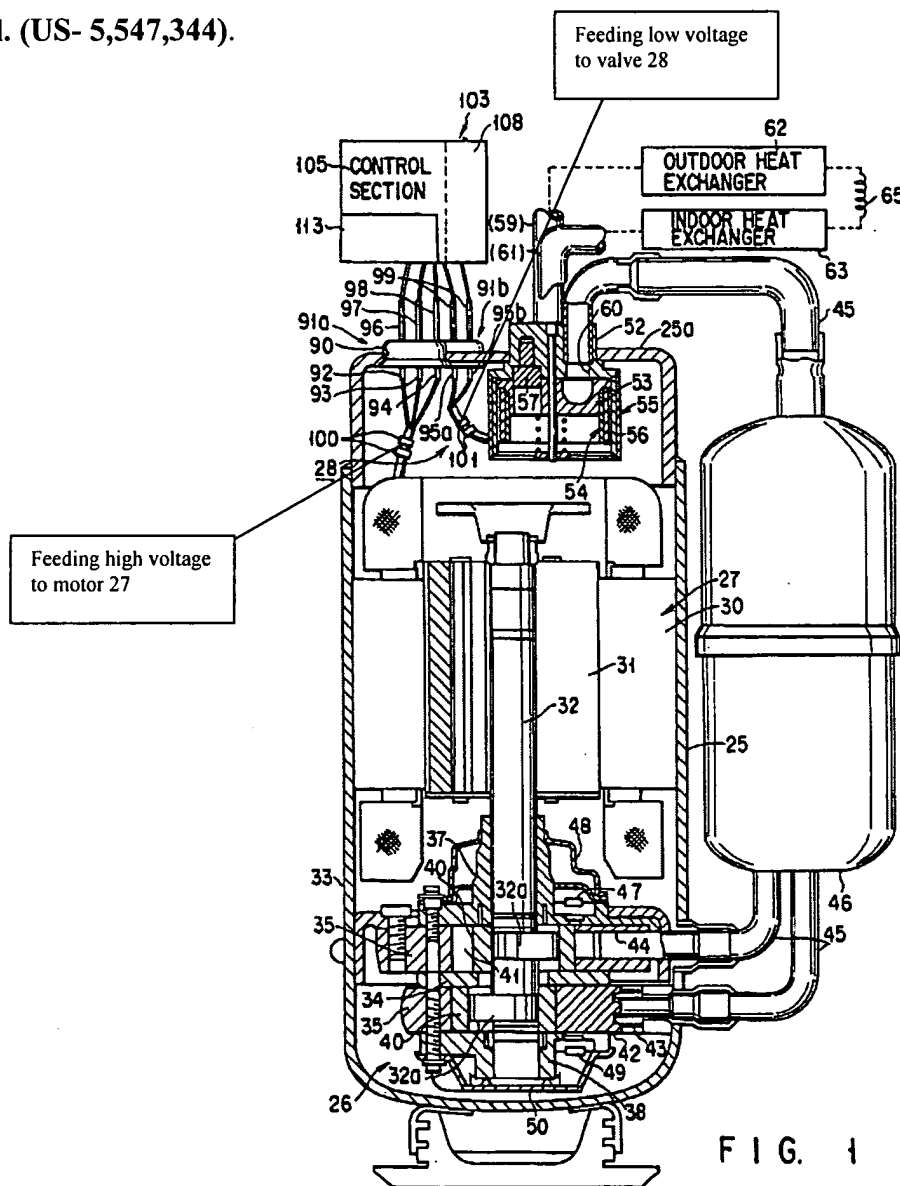
Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by **Sugiyama et al. (US- 5,547,344)**.



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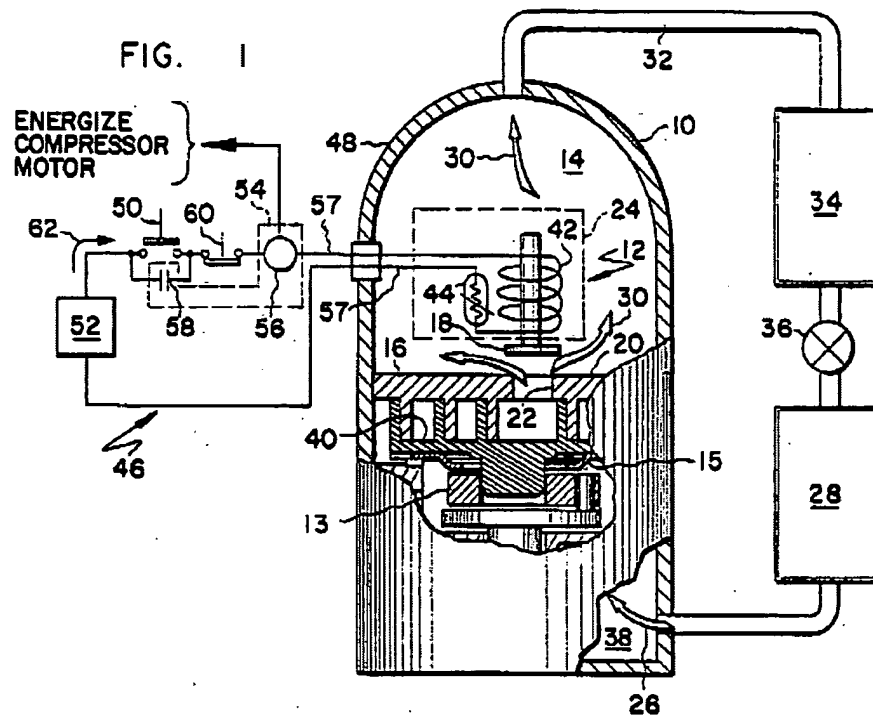
With respect to claim 12, **Sugiyama** teaches a compressor comprising: a sealed compressor shell (25a, 33) housing a compressor pump, an electric motor 27 for driving said compressor pump unit, and a low voltage valve 28 associated with the compressor pump unit, said pump unit, said electric motor and said low voltage valve all being received within said compressor shell (25a, 33), said electric motor requiring a higher voltage power than said low voltage valve 28 (see Figure 8a, 9a); an inlet opening in said compressor shell for receiving an incoming high volt electric power supply for powering said electric motor 27; and a system 103 for converting said incoming high voltage electric power to a low voltage electric power; and feeding low volt electric power to said low voltage valve. See particularly **Figures 1, 8a, 9a, 23, 24** and column 10 lines 11-14 of Sugiyama.

With respect to claim 13, **Sugiyama** teaches that said compressor pump unit is a scroll compressor pump unit. See column 27 lines 5-11 of Sugiyama.

With respect to claim 14, **Sugiyama** teaches that a low voltage sensor 113 is also supplied with low voltage electrical power from said converting system 103. See particularly **Figures 1, 8a, 9a, 23, 24** of Sugiyama.

With respect to claim 15, a transformer is an inherent feature in a system for stepping down a high voltage.

9. Claims 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by **Eber et al.**
(US- 4,820,130).



With respect to claim 12, **Eber** teaches a compressor comprising: a sealed compressor shell 10 housing a compressor pump, an electric motor for driving said compressor pump unit, and a low voltage valve 12 associated with the compressor pump unit, said pump unit, said electric motor and said low voltage valve 12 all being received within said compressor shell 10, said electric motor requiring a higher voltage power than said low voltage valve 12 (see column 4 lines 30-34); an inlet opening in said compressor shell for receiving an incoming high voltage electric power supply for powering said electric motor; and a system for converting said incoming high voltage electric power to a low voltage electric power (inherent since compressor motors typically work with higher voltages than the monitoring devices such as valves, sensor);

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and feeding low volt electric power to said low voltage valve 12. See particularly **Figure 1** and column 4 lines 30-34 of Eber.

With respect to claim 13, **Eber** teaches that said compressor pump unit is a scroll compressor pump unit.

With respect to claim 14, **Eber** teaches that a low voltage sensor 44 is also supplied with low voltage electrical power from said converting system. See particularly **Figure 1** of Eber.

With respect to claim 15, a transformer is an inherent feature in a system for stepping down a high voltage.

With respect to claim 16, **Eber** teaches a scroll compressor comprising: a sealed compressor shell 10 housing a compressor pump, an electric motor for driving said compressor pump unit, a low voltage valve 12 and a low voltage sensor 44 both associated with the compressor pump unit, said pump unit, said electric motor, said low voltage valve 12 and said low voltage sensor 44 all being received within said compressor shell 10, said electric motor requiring a higher voltage power than said low voltage valve 12 (see column 4 lines 30-34); an inlet opening in said compressor shell for receiving an incoming high voltage electric power supply for powering said electric motor; and a system for converting said incoming high voltage electric power to a low voltage electric power (inherent since compressor motors typically work with higher voltages than the monitoring devices such as valves, sensor); and feeding low voltage electric power to said low voltage valve 12. See particularly **Figure 1** and column 4 lines 30-34 of Eber.

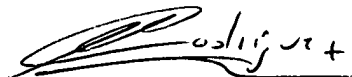
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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Rodriguez whose telephone number is 571-272-4831. The examiner can normally be reached on Monday-Friday 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Rodriguez
Examiner
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